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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,055	05/06/2004	John Blake Slemmer	BE1-0049US	6635

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EXAMINER	
IWUCHUKWU, EMEKA DERRICK	
ART UNIT	**PAPER NUMBER**
2617	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/840,055	SLEMMER ET AL.	
	Examiner	Art Unit	
	Emeka D. Iwuchukwu	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Amendment

2. This Office Action is in response to the amendment filed on 02/24/06.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 9&20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "from the message server" in Line 2. There is insufficient antecedent basis for this limitation in the claim. The Office shall interpret the claim to read "from a message server".

Claim 20 recites the limitation "to the satellite" in Line 10. There is insufficient antecedent basis for this limitation in the claim. The Office shall interpret the claim to read "to a satellite".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1,4,6,7,9,15,17&20** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2005/0236470 to Hirayma.

Wiedeman teaches a method of and system for delivering a stored message to a satellite radio receiver, the method and system comprising: means for receiving a request from a subscriber via a wireless communication device (wireless pager) associated with a first subscription service to retrieve the subscriber's personal text message (Col 10 Lines 21-23); means for retrieving the message from a message server of a second subscription service (Col 7 Lines 29-32); means for encoding the message via a server for satellite transmission (Col 7 Lines 43-45,65-67); and transmitting the message to a satellite via the second subscription service (Col 7 Lines 48-51) for delivery to the satellite radio receiver, wherein the satellite radio receiver decodes the message (Col 9 Lines 44-46,6-10) including uplinking the message to a satellite (Col 7 Lines 29-32).

Wiedeman fails to expressly disclose the request is protected with a password associated with the subscriber or the server encoder means or the method embodied as instructions of a computer program stored on a computer readable medium.

In the same field of endeavor, Hirayma teaches a similar method wherein receiving the request includes receiving a password associated with the subscriber (paragraph 55) and a server encoder means (4, Fig 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a password associated with the subscriber for the advantage of increased security as taught by Hirayma (paragraph 55) and to use a server for a more reliable method.

Hirayma also teaches a similar method embodied as instructions of a computer program stored on a computer readable medium (paragraph 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the method as a computer program on a computer readable medium so that it can be transported and implemented on a remote location.

8. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2005/0236470 A1 to Hirayma further in view of U.S. Patent Publication 2005/0239399 A1 to Karabinis.

Wiedeman in view of Hirayma teaches the method of claim 1. The combination fails to expressly disclose that the satellite radio receiver is selected from the group of satellite radio receivers consisting of a subscription satellite music receiver and a subscription satellite television set top box.

In the same field of endeavor, Karabinis teaches a similar device which is either a pager or satellite music receiver (paragraph 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the option of either a pager or satellite music receiver for the advantage of having a more versatile, user-friendly method, which could lead to more subscribers.

9. **Claims 3&5** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2005/0236470 A1 to Hirayma further in view of U.S. Patent Publication 2004/0120273 A1 to Border et al. *(hereinafter Border)*.

Wiedeman in view of Hirayma teaches the method of claim 1. The combination fails to expressly disclose that the wireless communication device can is a wireless telephone or PDA.

In the same field of endeavor, Border teaches a similar method wherein the request to retrieve a message is sent via a wireless telephone or PDA (paragraph 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive the request from a pager, a telephone or PDA for the advantage of having a more versatile, user-friendly method, which could lead to more subscribers.

10. **Claims 10-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2005/0236470 A1 to Hirayma.

Wiedeman in view of Hirayma teaches the method of claim 9. The combination fails to expressly disclose retrieving the message includes retrieving electronic mail message, electronic fax message, a voice message or wherein encoding the message for satellite transmission includes converting the message to a voice message. However the Examiner takes official notice

that retrieving e-mail, e-fax or voice message and converting a message to a voice message were well known in the art at the time the invention was made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Wiedeman in view of Hirayma to include retrieving e-mail, e-fax or voice message and converting a message to a voice message for the advantage of having a more versatile method compatible with different messaging formats.

11. **Claim 14&19** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2005/0236470 A1 to Hirayma further in view of U.S. Patent Publication 2003/0006910 to Dame.

Wiedeman in view of Hirayma teaches the method and program of claims 1&17. The combination fails to expressly disclose encoding the message for satellite transmission includes digitizing the message.

In the same field of endeavor, Dame teaches similar method including digitizing the message (paragraph 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to encode the message for satellite transmission by digitizing for increased security during transmission.

12. **Claims 16&18** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2005/0236470 A1 to Hirayma further in view of U.S. Patent Publication 2003/0028890 A1 to Swart et al. *(hereinafter Swart).*

Wiedeman in view of Hirayma teaches the method and program of claims 1&17, further comprising receiving the message from the satellite at the satellite radio receiver (Col 11 Lines 11-13); and decoding the message (Col 11 Lines 11-13). The combination fails to expressly disclose converting the message to an audio message and presenting it in audio form.

In the same field of endeavor, Swart teaches converting the message to an audio message and presenting the message in audio form (paragraph 56,107,112).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to present the message in audio form for compatibility as taught by Swart (paragraph 112).

Response to Arguments

14. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDI

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PRIMARY EXAMINER